

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Kirkland et al.** §
§ Confirmation No.: **5894**
Serial No. **10/660,013** §
§ Group Art Unit: **2162**
Filed: **September 11, 2003** §
§ Examiner: **Ly, Anh**
For: **Method and Apparatus for** §
Searching Universal Resource §
Identifiers §

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

REPLY BRIEF (37 C.F.R. 41.41)

This Reply Brief is submitted in response to the Examiner's Answer mailed on April 21, 2008.

No fees are believed to be required to file a Reply Brief. If any fees are required, I authorize the Commissioner to charge these fees, which may be required to IBM Corporation Deposit Account No. 09-0447.

RESPONSE TO EXAMINER'S ANSWER

Claims 8-13 have been rejected under 35 U.S.C 101 as being non-statutory because “the claimed steps are being performed by software, not by a computer hardware component. It fails to fall with one of four statutory categories of invention, process, machine, manufacture, and composition. Thus it is software per se.” (See Examiner’s Answer, mailed April 21, 2008, page 4). Appellants respectfully disagree and traverse this rejection.

35 U.S.C 112, 6th paragraph states “An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” Appellants’ Specification recites many structures that correspond to the means recited in claims 8-13. Further, Appellants pointed out at least one physical structure that corresponds to each means recited in claim 8 in the Summary of Claimed Subject Matter portion of the Appeal Brief.

For example, the receiving means for receiving the search statement was pointed to as element 320 of Figure 3, which is keyboard/mouse. However, any number of other devices, such as modem 322, lan adapter 310, audio adapter 316, audio/video adapter 319, modem 218, and processors 202, 204, and 302, could all also have been pointed to as various components that are capable of receiving the input. Retrieving means for retrieving a set of universal resource identifiers was pointed to as modem 218 of Figure 2. However, any number of other devices, such as modem 322, lan adapter 310, and processors 202, 204, and 302, could all also have been pointed to as various components that are capable of retrieving a set of universal resource identifiers. The parsing means was pointed as processors 202 and 204 of Figure 2. However, processor 302 could also have been pointed to as the parsing means. The returning means for returning the search results was pointed to as keyboard/mouse 320 of Figure 3. However, any number of other devices, such as modem 322, lan adapter 310, audio adapter 316, audio/video adapter 319, modem 218, and processors 202, 204, and 302, could all also have been pointed to as various components that are capable of returning the search results. Thus, claim 8 and claims 9-13 are not computer program product per se and are statutory.

Even assuming *arguendo* that claims 8-13 could be considered as reciting only software components performing functions, according to *State Street Bank* “Therefore, computer software configured to run on a general purpose computer, if claimed in means-plus-function patent language, is

considered a new machine or apparatus as a matter of patent interpretation." (*State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 927 F. Supp. 502, 38 USPQ2d 1530 (D. Mass. 1996)).

Further, on page 4 of the Examiner's Answer mailed on April 21, 2008, the Examiner's Answer states:

Moreover, in the instant specification, describes "data processing system" as a form of a computer-readable storage medium, which is a type of signal bearing media: "It is important to note' that while the present invention has been described in the context of a fully functioning data processing system, those of ordinary skill in the art will appreciate that the processes of the present invention are capable of being distributed in the form of a computer readable medium of instructions and a variety of forms and that the present invention applies equally regardless of the particular type of signal bearing media actually used to carry out the distribution. "(see page 18, lines 14-23).

Appellants respectfully disagree. Appellants' Specification does not describe a data processing system as a form of computer-readable storage medium. Rather, the Specification, as quoted by the Examiner states that the invention has been described in the context of a fully functioning data processing system, which is all the quoted statement says about a data processing system. The quoted passage goes on to state that **processes** of the present invention **are capable of being distributed in the form of a computer readable medium**. Thus, processes are capable of being distributed via computer-readable medium. This not the same as stating that a data processing system is a computer-readable medium as asserted by the Examiner. Therefore, the Specification does describe a data processing system as being a computer-readable storage medium.

Therefore, for at least the reasons set forth above, Appellants respectfully submit that claims 8-13 are directed to statutory subject matter and that the rejection of claims 8-13 under 35 U.S.C 101 has been overcome.

/Gerald H. Glanzman/

Gerald H. Glanzman

Reg. No. 25,035

YEE & ASSOCIATES, P.C.

PO Box 802333

Dallas, TX 75380

(972) 385-8777

GG/blj